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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,790	04/16/2004	Edward A. O'Donnell	TKG4360	6668

34356 7590 03/02/2005

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EXAMINER

WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/824,790

Applicant(s)

O'DONNELL, EDWARD A.

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The specification and abstract of the disclosure is objected to because they use the trademark "VELCRO". The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 7 depends from cancelled claim 5. This renders the claim indefinite.

5. Claim 13 depends from cancelled claim 11. This renders the claim indefinite.

6. Claim 1 recites "means for selectively maintaining said mast section at a substantially stable position" in lines 15-16. This recitation invokes 35 USC 112, 6<sup>th</sup> Paragraph, because it: (a) uses the phrase "means for"; (b) modifies the phrase "means for" with functional language; and (c) does not modify the phrase "means for" with structure for achieving the function. From MPEP 2181:

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

The disclosure does not identify the corresponding structure that performs the recited function of claim 1. The disclosure describes a "mast maintaining mechanism" on page 5. Due to inconsistent language, it is not clear if this is the corresponding structure. And if the mechanism is the corresponding structure, then it is unclear if the corresponding structure is the halyard and cleat, or the halyard, cleat, and VELCRO. Since the corresponding structure is not properly identified, it is impossible for the skilled artisan to determine the corresponding structure and its equivalents. 35 USC 112 6<sup>th</sup> Paragraph states that: "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." If one cannot determine the corresponding structure and equivalents thereof, then one cannot determine the statutory scope of the claim coverage. Thus the claim is indefinite. Therefore the claim fails to satisfy 35 USC 112 2<sup>nd</sup> Paragraph. Claims 2-7. depend from claim 1 and are rejected for the same reason. Claim 8 has a similar

recitation and claims 9-13 depend from claim 8. For examination it will be assumed that the corresponding structure is the: halyard, cleat, and VELCRO member.

***Allowable Subject Matter***

7. Claims 1-4, 6-10, 12, and 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Response to Arguments***

8. Applicant's arguments filed 1/28/05 have been fully considered but they are not persuasive. Applicant requests that all references to the trademark VELCRO in the specification be corrected by examiner's amendment. Applicant is reminded that it is applicant's responsibility, not the examiner's, to put the application in condition for allowance. Therefore, the objection has been maintained.

9. Applicant states that "applicant further agrees with the examiner that the corresponding structure of the mast maintaining mechanism is the halyard, cleat, and VELCRO, member...". This remark apparently is directed toward the 35 USC 112 2<sup>nd</sup> Paragraph rejection regarding the invocation of 35 USC 112 6<sup>th</sup> Paragraph. Applicant's assertion of the corresponding structure in remarks during the prosecution does not cure the noted defect. The claim is still indefinite because a person reading the claims and specification cannot ascertain the scope of the claims because the corresponding structure of the means-plus-function claim language is not clearly identified in the specification. Therefore, the rejection has been maintained.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

The examiner and his supervisor are relocating to the new Office campus in Alexandria, VA, on or around April 11, 2005. Telephone calls to the examiner and/or examiner's supervisor after that date should be directed as follows. The examiner's new telephone will be (571) 272-6690. The examiner's fax number for unofficial

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communications will be (571) 273-6690. The supervisor's new telephone number will be (571) 272-6684.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

*AW 2/27/05*  
**ANDREW D. WRIGHT**  
**PRIMARY EXAMINER**